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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,174	01/17/2002	Carol Myers	4532670/58750	3165

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EXAMINER

HENDRICKS, KEITH D

ART UNIT PAPER NUMBER

1761

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/052,174

Applicant(s)

MYERS ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9-11-2002. 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The phrase “selected from the group comprising”, in claims 1, 4 and 5, is indefinite. Due to this phrase, the metes and bounds of the claimed invention are unclear. It is unclear whether the recited list is an open or closed grouping. Applicant is encouraged to amend the claims to recite accepted Patent language: “comprising” for an open set, or “selected from the group consisting of” for a closed set.
- A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation “comprises”, and the claim also recites “of the group consisting of”, which is the narrower statement of the range/limitation. It is unclear whether other organic acids which are not recited in claim 2, may be present within the organic acid component.

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- In claim 5, the phrases “wet and dry brewers grains”, and “wet and dry sugar beet pulp” are indefinite, as it is unclear if these denote a mixture of both (for example, wet sugar beet pulp and dry sugar beet pulp together), or if these are each separate (i.e., wet sugar beet pulp or dry sugar beet pulp). Note that optional components must be listed in the alternative only, minding the rejections above.
- Claim 5 is indefinite, as not all of the recited components are “grain products”, as required by the claim. These include cottonseed products, almond hulls, sugar beet pulp, canola meal, citrus pulp, safflower meal, soybean hulls, and food processing waste.

Claim Objections

Claims 1, 3 and 5 are objected to because of the following informalities

In claim 1, it is suggested that the term “(d)” be deleted, as the recitation that follows does not actually describe a component of the composition utilized within the claimed invention. Note the structure of the claim.

Also in claim 1, it is noted that the recitation of part (d), concerning the application of the composition to a grain product and the reduction of microbes, does not further limit the claimed invention, as the claim is directed to a composition, regardless of how it is used or its subsequent effect.

Claim 5 is objected to because of the following informalities:

At line 2, the term “wt” should be “wet”.

At line 2, the term “distillers” (2nd occurrence) should be “distiller’s”. See first occurrence.

Similarly, “brewers”, should be “brewer’s”.

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The amount of grain product consumed by an animal does not further limit or affect the composition of claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

i) Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Huitson et al. (US PAT 3,595,665).

Huitson et al. disclose the inhibition of mold growth on various crops, grains and/or animal feed, by the addition of organic acids or mixtures of said acids. “The acid is preferably added in amounts 0.1 to 10% by weight of the dry crop, and may be added as an aqueous solution” (abstract). At the bottom of column 1, it is shown that, for example, a mixture of formic and propionic acid may be utilized, with ratios of between 10-70% formic acid and 30-90% propionic acid. This reads upon the compositions recited in the independent claims, as parts (b) and (c) of instant claims 1 and 4 state that the other components are not required (i.e. “between about 0 and about 10 weight percent”).

Note that the recitation of the phrase “to maintain or reduce the level of microbes in the main product at or below the initial levels for a period of not less than 7 days” would be an inherent function of the composition upon addition to a grain product, as in instant claims 4-5. However, as stated above, this does not directly affect or limit the composition of claim 1, *per se*. The limitations recited in instant claim 3 also do not affect or alter the actual composition claimed.

ii) Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Matyas et al. (US PAT 3,846,567).

Matyas et al. disclose a vegetable product preservative comprising a powdery mixture of an organic carboxylic acid, and a solid dispersant particle. “The powder products according to the invention comprise 50-95 percent... of a liquid substance”, wherein the liquid substance is an organic acid such as formic, acetic or preferably, propionic (col. 1). This reads upon the compositions recited in the independent claims, as parts (b) and (c) of instant claims 1 and 4 state that the other components are not required (i.e. “between about 0 and about 10 weight percent”). The propionic acid powder mixture is applied “with the product to be preserved in a ratio so that the preserved product contains 0.1-3 percent

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propionic acid" (col. 2, lines 10-12). The various products with which the preservative may be used are recited at column 3, lines 26-38.

Note that the recitation of the phrase "to maintain or reduce the level of microbes in the main product at or below the initial levels for a period of not less than 7 days" would be an inherent function of the composition upon addition to a grain product, as in instant claims 4-5. However, as stated above, this does not directly affect or limit the composition of claim 1, *per se*. The limitations recited in instant claim 3 also do not affect or alter the actual composition claimed.

iii) Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Fahnenstich et al. (US PAT 3,982,026).


Fahnenstich et al. provide a silage aid in the form of propylene glycol esters of propionic acid. "Generally it is suitable to add to the silaging material at least about 0.01 to about 1.0 weight percent of ester" (col. 1, lines 56-58). "The esters used as additives in the invention can be used with all kinds of silage, especially silage from plants such as grass, alfalfa, vetch grains, clover, green corn, beets and potatoes" (top, col. 2). As parts (a) and (c) of the instant independent claims 1 and 4 provide for the use of propionic acid and propylene glycol together, the instant claims are anticipated by the reference. It is noted that within the compositions recited in the independent claims, part (b) states that the other components are not required (i.e. "between about 0 and about 10 weight percent"). Note that the recitation of the phrase "to maintain or reduce the level of microbes in the main product at or below the initial levels for a period of not less than 7 days" would be an inherent function of the composition upon addition to a grain product, as in instant claims 4-5. However, as stated above, this does not directly affect or limit the composition of claim 1, *per se*. The limitations recited in instant claim 3 also do not affect or alter the actual composition claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KEITH HENDRICKS
PRIMARY EXAMINER